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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/439,095 05/11/95 MATSUI

T. 40399/119

EXAMINER
MARSCHEL, A

18M2/0624

ART UNIT PAPER NUMBER

45

FOLEY & LARDNER
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1807

DATE MAILED: 06/24/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 5-11-95
11-28-95 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☐ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

- ☒ Claims 2-16, 18, 19, and 22-25 are pending in the application.
Of the above, claims 8-15 are withdrawn from consideration.
- ☒ Claims 1, 17, 20, and 21 have been cancelled.
- ☒ Claims 2, 3, 7, 16, 18, 19, and 22 are allowed.
- ☒ Claims 4-6, 23, and 24 are rejected.
- ☒ Claims 25 is ~~are~~ objected to.
- ☒ Claims 2-16, 18, 19, and 22-25 are subject to restriction or election requirement.
- ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
- ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

EXAMINER'S ACTION

PTOL-326 (Rev. 2/93)

08/439095

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 24 is rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to the DNA of claim 25. Applicants argue that the sequence of the β PDGF receptor is disclosed in Yarden et al. This disclosure is essential subject matter for the practice of claim 24 as indicated in the previous office action. The lack of this sequence disclosure in the specification as filed supports this lack of enablement which is required for essential subject matter. Applicants have not set forth any other enablement for this sequence other than via the cited publication. Applicants have not supported the concept that this sequence is well known because a "single" publication lacks support for such a concept as being well known. It is noted that this publication is cited in the disclosure as filed. It is however improper to enable essential subject matter by incorporation by reference of a printed publication. See the following paragraph. See M.P.E.P. §§ 706.03(n) and 706.03(z).

The incorporation of essential material by reference to a foreign application or foreign patent or to a publication inserted in the specification is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or applicant's attorney or

agent, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. *In re Hawkins*, 486 F.2d 569, 179 USPQ 157; *In re Hawkins*, 486 F.2d 579, 179 USPQ 163; *In re Hawkins*, 486 F.2d 577, 179 USPQ 167.

Claims 4-6 and 23 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 23 is vague and indefinite in that the phrase "also binds...at high affinity" has no antecedent basis as the claim is worded for the word "also".

Claims 2-7, 16, 18, and 22-25 are allowable over the prior art of record because the α PDGF receptor DNA and protein is neither taught nor suggested by the prior art of record.

Claim 25 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 2, 3, 7, 16, 18, 19, and 22 are allowed.

Papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 305-3014 or (703) 308-4227.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are

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unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

June 21, 1996

Ardin H. Marschel

ARDIN H. MARSCHEL
PATENT EXAMINER
GROUP 1800